



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Donald L. Morton

Serial No.: 07/431,533

Filed: November 3, 1989

For: URINARY TUMOR ASSOCIATED
ANTIGEN, ANTIGENIC SUBUNITS
AND METHODS OF DETECTION

Group Art Unit: 1642

Examiner: M. Davis

Atty. Dkt. No.: CADL:002/SLH

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REQUEST TO PROCEED ON APPEAL

Hon. Assistant Commissioner for Patents
Washington, DC 20231
ATTN: GROUP 1600 DIRECTOR

Sir:

This is a request to proceed with the appeal for the above-captioned application, the appeal having been terminated by the examiner's reopening of prosecution. The salient facts are as follows:

On June 13, 1997, applicants filed a Notice of Appeal for the above-captioned application. On August 18, 1997, applicants filed a Brief on Appeal. On November 4, 1997, the examiner issued a non-final Office Action in which prosecution on the merits was reopened. In

the action, the examiner withdrew rejections under 35 U.S.C. §102 and §103. In addition, the examiner posed nine new grounds of rejection, including one previously withdrawn.

In the hopes that the reopened prosecution would lead to progress towards allowance, applicant readily accepted this new action. However, since that time, no meaningful progress has been made despite numerous submission on applicant's behalf. Moreover, the present non-final action appears to be nothing more than a rearrangement of previous references into what amounts to the same rejections.

The PTO has a policy against "piece-meal" prosecution. Examiners are expected raise all valid rejections at the same time to expedite prosecution rather than posing rejections *seriatim*. Clearly, this policy has not been adhered to in this case. Applicant realizes that multiple examiners have been involved but, nonetheless, it is unfair to delay the prosecution in this matter when the PTO has had an ample opportunity to raise each of the new rejections now advanced.

Moreover, applicant has incurred considerable expense, both in government fees and attorney costs, in placing this application on appeal *twice*. Quite possibly, applicant will be forced to again proceed with an appeal, at which time the examiner may decide to reopen prosecution yet another time, further adding to the expense. The possibility of this vicious circle must be eliminated.

Thus, applicants respectfully request, in the interest of conserving time, applicant's finances and the PTO's resources, that the examiner be forced to raise these new rejections in the

context of the appeal. Should any interested person believe that further discussion of this matter is required, a call to the undersigned at the telephone number listed below is invited.

No fees are believed due in connection with this petition. However, should any fees be due, applicant authorizes the Assistant Commissioner to debit Fulbright & Jaworski Deposit Acct. No. 50-1212/CADL:002/HYL.

Respectfully submitted,



Steven L. Highlander
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Attorney for Applicant

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Date: July 26, 2000

AF/GP 1642

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July 26, 2000

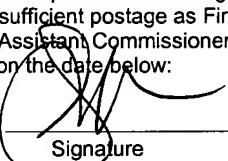
FILE: CADL:002



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Assistant Commissioner for Patents
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RE: SN 07/431,533 "URINARY TUMOR ASSOCIATED ANTIGEN, ANTIGENIC SUBUNITS AND METHODS OF DETECTION" - Donald L. Morton **RECEIVED**

Sir:

AUG 03 2000

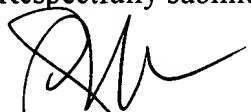
Please find enclosed:

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1. Request to Proceed on Appeal; and
2. A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Assistant Commissioner is authorized to deduct said fees from Fulbright & Jaworski Account No.: 50-1212/CADL:002/SLH.

Respectfully submitted,



Steven L. Highlander
Reg. No. 37,642

SLH/cpj
Encl: